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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,513	03/30/2000	Fumio Sumi	43889-934	8512
20277	7590	11/16/2004	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			PSITOS, ARISTOTELIS M	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DT

Office Action Summary	Application No.	Applicant(s)	
	09/538,513	SUMI ET AL.	
	Examiner	Art Unit	
	Aristotelis M Psitos	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 15 and 16 is/are allowed.
- 6) Claim(s) 1,2 and 6-14 is/are rejected.
- 7) Claim(s) 3 and 4 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 31604
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/04 has been entered.

In accordance with MPEP § 704.01, the following action is taken.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-2, 5, 7-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Houston et al.

With respect to claims 1, 11 and 14, it is noted that Houston et al disclose in an optical disc drive a SMART system – which inherently provides for the ecc section, status generator and the status sampling section, see for instance the description at col. 2 lines 34-64, col. 6 lines 31-48, col. 8 lines 51-59, and col. 10 lines 28-35 for further description of such sections.

With respect to claim 2, since the tests/status is/are read appropriately, the examiner concludes that the system inherently has the ability for setting a status-sampling interval.

With respect to claim 5, since there is external input command ability, this limitation is inherently met.

With respect to claims 7, 8, see the discussion with respect to figure 3E and when the bit is a "2" value, the abort off-line; suspend/resume and abort indications which the examiner interprets meets these limitations as claimed.

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With respect to claims 9 and 10, see the discussion with respect to the attributes, as depicted and described with respect to figures 4,a, b, & c, which the examiner interprets as meeting the ability of sampling a category information representing a relationship and a factor, as recited.

With respect to claim12, the Houston et al system has a controller/microprocessor, which meets the claimed limitation – see the description of the response of the controller when the events are reported/recognized.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above, and further in view of Kim.

With respect to the ability of varying the sampling rate predicated upon error rate, note the description in col. 2 lines 35 plus in Kim. The examiner interprets the ability of varying the threshold for the decoding/error rate as meeting this limitation.

It would have been obvious to modify the base system of Houston et al with the above additional teaching of varying the sampling rate predicated upon error rate so as to permit a faster response time to the overall system.

3. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Arai.

Arai discloses in the optical disc testing environment, the ability of generating a status report(s) with respect to the operating condition of the disc system and providing the ability of "retrying" for various conditions. Note that during the retry the ability of executing the retry predicated upon the existence of a previous retry exists. The examiner interprets such as decreasing the number of "samplings" of the status report(s) in accordance with the claim language.

Allowable Subject Matter

Claims 15 and 16 are allowable for the reasons stated in the previous OA.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Claims 3 and 4 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 15 and 16 respectively. When two claims in an application are duplicates or else are

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so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lenny and Klingsporn et al are cited as illustrative of alternative testing systems in this environment and especially Lenny can be relied upon in place of Houston et al as the primary reference in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

AMP

